

### REMARKS / ARGUMENTS

This amendment is submitted in full response to the outstanding Office Action dated March 2, 2004, wherein claims 1-11 remain in this application and original claims 12-23 stand withdrawn based on a previously applied restriction requirement. Moreover, claims 1, 4, 5, 6, 7, 8 and 9 stand rejected under 35 U.S.C. 102(b) as being anticipate by Makikawa (U.S. Patent 5,902,214). Also claims 1 and 2 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Hoyle et al. (U.S. Patent 4,337,939). In addition, claims 1, 10 and 11 stand rejected under 35 U.S.C. 102(b) as being anticipated by Hotas (U.S. Patent No. 3,020,046). Finally, claim 3 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Hoyle et al in view of McIntyre (U.S. Patent No. 4,650,183).

For the reasons set forth in greater detail hereinafter, the outstanding rejections of claims 1-11 are respectfully traversed.

### ISSUES UNDER 35 U.S.C. 102 AND 103

Before reviewing the substantive issues with regard to the rejections of the claims under 35 U.S.C. 102 and 103, Applicant respectfully points out the well established requirement that:

For a prior art reference to anticipate in terms of 35 U.S.C. §102, **every** element of the claimed invention must be **identically** shown in a single reference. Diversitech Corp. v. Century Steps, Inc., 7 USPQ2d 1315, 1317 (Fed. Cir. 1988) (emphasis added).

Moreover, this burden on the U.S. Patent and Trademark Office is further compounded by the fact that the Federal Circuit has stated that within the single reference:

[t]he identical invention must be shown in as complete detail as is contained in the patent claim. Richardson v. Suzuki Motor Co. Ltd., 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

And, more recently, the Federal Circuit has further expanded this principle to include that:

An anticipating reference must describe the patented subject matter with sufficient clarity and detail to establish that the subject matter existed in the prior art and that such existence would be recognized by persons of ordinary skill in the field of the invention. Crown Operations Int'l, Ltd. v. Solutia Inc., 289 F.3d 1367, 62 USPQ2d 1917, 1921 (Fed. Cir. 2002).

As such, if an Applicant can establish that at least one claimed element is not present or is not identically disclosed in complete detail in the prior art reference put forth by the PTO, the grounds for rejection pursuant to 35 U.S.C. §102 of each claim comprising that element have been overcome. Furthermore,

once the grounds for rejection under 35 U.S.C. §102 have been overcome, the PTO can not merely turn to 35 U.S.C. §103 as a basis for maintaining a rejection without first meeting the requisite burden. Specifically, the decisions of the Federal Circuit instruct that:

In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art [and further that] the mere fact that the prior art **may** be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). (emphasis added).

Recently, this point was further emphasized by the Federal Circuit, which added that:

To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the [Examiner] to show a motivation to combine the references that create the case of obviousness. In other words, the [Examiner] must show reasons that the skilled artisan, confronted with the same problems as the inventor (**and with no knowledge of the claimed invention**), would select the elements from the cited prior art references for combination in the manner claimed. (emphasis added).

#### Applicant's Invention

Applicant's invention as now defined in the new and amended claims presented herein is directed to an exercise assembly structured to exercise the leg-ankle-foot portion of a user's

body. As such, the exercise assembly comprises a platform for the support of a foot of the user thereon, a base innerconnected in supporting relation to the platform and a support assembly, which movably innerconnects and supports the platform relative to the base. More specifically, the support assembly includes a support structure having a curvilinear length and a substantially semicircular configuration. In addition, the support structure of Applicant's invention is more specifically defined as having opposite free ends, each of which are connected to the platform and a mid-portion of the curvilinear length movably connected to the base. Moreover, the support structure is disposed and dimensioned relative to the base and the platform to substantially align a diameter of the semicircular configuration of the support structure with a true center of articulation of the ankle joint. As such, the platform and the support structure are cooperatively structured to direct the platform through a plurality of axes of rotation which collectively define a plurality of paths of movement.

A review of each of the primary references of record to Makikawa et al., Hoyle et al., Hotas and McIntyre, when considered either singularly or in combination with one another, indicate an absence of specific structural features included in

newly submitted independent claim 24, as well as the new and amended dependent claims remaining in this application.

More specifically, none of the cited references of record disclose a support assembly comprising a support structure having a curvilinear length and a substantially semicircular configuration, wherein the free ends of the support structure are connected to the platform and further wherein a mid-portion of the circular length is movably connected to a base of the exercise assembly. This unique and clearly distinguishable structural feature of the support assembly accomplishes a substantial alignment of a diameter of the semicircular configuration of the support structure with a true center of articulation of the ankle joint. In turn, the platform and the support structure, being cooperatively structured in the manner now defined allows movement of the platform through a plurality of axes of rotation collectively defining a plurality of paths of movement.

In support of the outstanding rejections, the Examiner recognizes that the references of record, specifically including Hoyle et al, fail to show a support structure which is substantially semicircular. To overcome this deficiency, the Examiner contends that it would have been apparent to

manufacture the support member 12 of Hoyle et al. into a semicircular shape in that any one of several shapes, such as a V shape or a U shape, could be substituted for the specifically defined configuration of Applicant's support structure as long as it includes two free ends. The Examiner further reasons that the interpretation of Hoyle et al. in the manner set forth above would be acceptable since Applicant has failed to present any reasoning why the particular configuration of a semicircular support member is significant or is anything more than one of numerous configurations obvious for the purpose of providing a support member having two free ends to connect to a platform.

Applicant respectfully disagrees with the Examiner's interpretation of Hoyle et al, particularly in reference to the configuration of the support structure 12. In the first instance, Hoyle et al. includes a support structure 12 which only allows pivotal movement of the platform 16 about a **single axes A** as clearly delineated in Figures 1 and 4 and described in detail in column 3. **The Examiner's attention is respectfully directed to pages 7 and 8 of the subject application,** wherein Applicant describes in specific detail the curvilinear length and semicircular configuration of the support structure and the reasons why the support structure, being so constructed, is an

important structural and operational feature of Applicant's invention. More specifically, as described in the indicated pages of the subject specification, the disposition and configuration of the support member or structure, incorporating a curvilinear length and a semicircular configuration accomplishes an alignment in corresponding relation to the transverse axis and rotational anti-lateral axes corresponding to the movements of the ankle. Further, the curvilinear length and semicircular configuration of the support structure is such that its diameter corresponds to or aligns with the true center of articulation of the ankle joint such that the diameter of the support structure, so formed, coextends with the rotational or bending movement or extension of the ankle during its various portions of rotation.

Based on the detailed description and indicated importance of the support structure, as now defined in independent claim 21, Applicant respectfully contends that the defined curvilinear length and semicircular configuration is significant and is not the equivalent of and/or could not be placed by "--- more than one of numerous configurations obvious for the purpose of providing support member having two free ends to connect to a

platform." (see Examiner's comments at page 3, paragraph 4 of the outstanding office action).

Accordingly, the Examiner's acknowledgement that Hoyle et al and presumably the remaining references of record are devoid of specific structural features of the support structure, as now defined in independent claim 24, overcomes the outstanding rejection of Applicant's presented claims under 35 USC 102. More specifically, all of the references of record fail to disclose at least one claimed element in sufficient detail as claimed so as to anticipate Applicants invention.

In addition, the mere fact that the prior art may be modified in the manner suggested by the Examiner, in support of the rejection under 35 USC 103, does not make such modification obvious, absent a motivation suggested by the prior art to do so. The hindsight knowledge of Applicant's invention can not be the basis of such motivation. Further, the Examiner's contention that a variety of structural modifications are substantially equivalent to Applicant's claimed support structure is mere speculation especially in light of the importance of the claimed structural features of the support structure as described in detail on pages 7 and 8 of Applicant's specification.



### Conclusion

Based on the above, Applicant contends that independent claim 24, as well as the remaining dependent claims present in this application, contain allowable subject matter through the recitation of specific structural features not found in the references of records, thereby distinguishing Applicant's claimed invention from these references.

Based on the above amendments and remarks, reconsideration of this application is hereby requested. It is believed that this application is now in condition for allowance and such action is respectfully requested.

In addition, a request for an appropriate extension of time is enclosed herewith along with the corresponding PTO fee. In the event that any additional fee may be required by the filing of this paper, the Commissioner is hereby authorized to charge any fees and/or credits to our **Deposit Account No. 13-1227**.

Respectfully Submitted,

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